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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,179	07/08/2002	Jochen A. Lauterbach	7024-507	4777

7590 11/17/2004
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EXAMINER

LEE, HWA S

ART UNIT PAPER NUMBER

2877

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,179	Applicant(s) LAUTERBACH ET AL.	
	Examiner Andrew Hwa S. Lee	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓ | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) ✓ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/19/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 2-22 in the reply filed on 10/18/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland et al (US 6,541,271).

With respect to independent claims 2, 12, 17, and 21, McFarland et al ("McFarland" hereinafter) show an infrared spectroscopic imaging of libraries comprising the steps of:

forming a library of discrete quantities of the plurality of different samples, placing the library in the sample chamber of a spectrometer;

- a) scanning of the spectrometer (i.e. column 15, lines 33-40);
- b) causing the spectrometer to scan the sample with infrared light (i.e. column 15, lines 19-20);

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c) triggering the detector (i.e. column 18, lines 59+) to measure absorption of light by the sample upon starting the scan

d) repeating steps (b)-(c) a predetermined number of times (i.e. column 18, lines 37+).

McFarland does not expressly say that the scan speed is selected. However, as taught by McFarland in column 15, lines 33-40 and as taught in column 12, line 24, "An IR detector 107 scans the library, either by repositioning the detector or by repositioning the library relative to the detector," it would be obvious to one of ordinary skill in the art that the scan speed is selected, otherwise the scan speed would be totally arbitrary.

With regards to claims 3 and 4, the sample comprises a combinatorial library with discrete quantities of a plurality of different samples.

With regards to claim 5, McFarland shows the sensor comprises a focal plane array (claim 37).

With regards to claim 6, the spectrometer includes an interferometer (column 16, lines 46+).

With regards to claims 7, 13, and 18, it would be obvious the spectrometer includes optical lenses suitable for use in the IR spectral range rather than lenses unsuitable for infrared light.

With regards to claim 8, McFarland the combinatorial library is transparent to infrared radiation (column 15, lines 20+)

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With regards to claim 9, McFarland shows the combinatorial library is in contact with a substrate reflective of infrared light (column 4, lines 30+).

With regards to claim 10, an infrared transparent prism with a refractive index higher than the sample for use in a combinatorial library is well known.

With regards to claims 11, 16, and 19 the group consisting of calcium fluoride (CaF_2), zinc selenide (ZnSe), and germanium (Ge) are well known for use with IR light.

With regards to claim 14, McFarland shows exposing the library to controlled conditions while illuminating the library with infrared light to evaluate the plurality of samples under the controlled conditions, including assigning one or more time series of absorbance spectra to each of the different samples of the library, evaluating the different samples based on the assigned absorbance spectra, assigning one or more time series of absorbance spectra to each of the different samples of the library, and evaluating the different samples based on the assigned absorbance spectra. (column 11-19).

With regards claim 20 to the filtering, please see column 15, lines 24+.

With regards to claim 22, please see column 14, lines 49+.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Hwa S. Lee whose telephone number is 571-272-2419. The examiner can normally be reached on Tue-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on 571-272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew Hwa S. Lee
Examiner
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